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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,864	04/27/2001	Martin M. Matzuk	P01925US2 (09807797)	1363
26271	7590	11/14/2003	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			WILDER, CYNTHIA B	
1301 MCKINNEY			ART UNIT	
SUITE 5100			PAPER NUMBER	
HOUSTON, TX 77010-3095			1637	

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/844,864	Applicant(s) MATZUK ET AL.	
	Examiner Cynthia B. Wilder, Ph.D.	Art Unit 1637	

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment to advisory action.

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 102(b) rejection directed to claim 23.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 23 and 25.

Claim(s) objected to: _____.

Claim(s) rejected: 24 and 26.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7/14/2003.
10. ☐ Other: _____

Attachment to Advisory Action

1. Applicant's amendment after-final filed on October 23, 2003 is acknowledged. However, the amendment has not been entered because the amendment raises issues that requires further search and consideration. Specifically, the amendment to claim 24 raises issues under 25 USC 112 first paragraph because the claim as written is not enabled for all hybridizable nucleic acid molecules encompassed by the claim as written. Additionally, it cannot be determined which hybridizable nucleic acid molecules or which complementary nucleic acid molecules would result in a functional nucleic acid sequence as set forth in claim 23 or encode the protein thereof. Likewise the claim as amended encompasses a large genus of hybridizable nucleic acid nucleic acid molecules not adequately disclosed or described. The claim further encompasses issues under 35 USC 112 second paragraph because the term "highly stringent" is a relative term of degree. The term is not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree. Therefore, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Likewise, it cannot be determine what conditions are necessary for the instant invention because the specification does not define what is considered "stringent".
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 9:30 am to 6:30 pm and on Friday from 9:30 am to 1:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0196.

Cynthia B. Wilder, Ph.D.
Examiner
Art Unit 1637

November 7, 2003


KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

11/12/03